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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389	7590	01/16/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			PHAN, HUY Q	
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			2685	8
DATE MAILED: 01/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

Huy Q Phan

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z. 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-10, 13-15, 19, 20 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Rinne et al. (US-6,574,473).

Regarding claims 1-3, Rinne et al. discloses in figure 3, a method of facilitating handover from an active network (32) with which User Equipment (35) is in communication to another network (33-34), the method comprising the steps of: providing a list of available other networks to said User Equipment via the active network (col. 5, lines 14-18); in the User Equipment, selecting among the available networks based on preference information (fig. 6B, step 624 and col.7, lines 56-65); and signalling to said active network at least one preferred other network; and providing neighbor cell information for the at least one preferred other network to said User Equipment via the active network (col. 5, lines 21-25).

Regarding claim 6, Rinne et al. discloses a method according to claim 2, as recited in the rejection of claim 2, further comprising a step of sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks (col. 8, lines 5-8 and col. 15, line 62-col. 16, line 5).

Regarding claim 7, Rinne et al. discloses a method of operating an active network to facilitate handover to another network comprising a step of providing to User Equipment communicating via the active network a message containing information for incrementally adding to or subtracting from a stored list of available networks (col. 15, line 62-col. 16, line 5).

Regarding claim 8, Rinne et al. discloses a method of operating User Equipment capable of handover between an active network and another network comprising a step of incrementally adding to or subtracting from a stored list of available networks based on information supplied by the active network with which the User Equipment is in communication (col. 8, lines 5-8).

Regarding claim 9, Rinne et al. discloses a method of operating User Equipment capable of handover between an active network and another network comprising a step of signalling to the active network with which the User Equipment is in communication a preferred other network for handover (col. 7, lines 56-65).

Regarding claim 10, Rinne et al. discloses a method according to claim 9, as recited in the rejection of claim 9, wherein said preferred other network is selected by the User Equipment from a list of available networks supplied by the network (figures 6A-6B, steps 614-621).

Regarding claim 13, Rinne et al. discloses a method according to claim 1, as recited in the rejection of claim 1, wherein the preferred other network is selected based on information stored in the User Equipment, preferably in a SIM card (fig. 3, box 36).

Regarding claim 14, Rinne et al. discloses a method according to claim 1, as recited in the rejection of claim 1, wherein the active network is a UMTS network and the other network is selected from available GSM networks (fig. 3, boxes 32-34)

Regarding claim 15, Rinne et al. discloses a method according to claim 1, as recited in the rejection of claim 1, wherein the active network is provided by an active network provider (fig. 3, box 34) and the other network is selected from networks provided by other network providers (fig. 3, box 32 and box 33).

Regarding claim 19, Rinne et al. discloses a user equipment for a mobile communications system capable of handover from an active network with which User

Equipment is in communication to another network comprising means for signalling a preferred other network to the active network during a call (col. 7, lines 56-67).

Regarding claim 20, Rinne et al. discloses a user equipment according to claim 19, as recited in the rejection of claim 19, further comprising means for storing network preference information (col. 7, lines 58-59).

Regarding claim 22, Rinne et al. discloses in figure 3, a mobile communications network (30) or component thereof including means for communicating to User Equipment (35) communicating with the network a list of available other networks (col. 5, lines 14-18).

Regarding claim 23, Rinne et al. discloses a mobile communications network or component thereof according to claim 22, as recited in the rejection of claim 22, having means for sending a message to the User Equipment containing information for incrementally adding to or subtracting from the list of available networks (col. 8, lines 5-8).

Regarding claim 24, Rinne et al. discloses a mobile communications network or component thereof including means for sending a message to User Equipment containing information for incrementally adding to or subtracting from a list of available networks stored in the User Equipment (col.7, line 56-col.8, line 8).

3. Claims 4 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Whinnett (GB-2,298,191).

Regarding claim 4, Whinnett discloses a method of operating User Equipment capable of handover between an active network and another network comprising a step of storing in the User Equipment a list of available networks based on information supplied by the active network with which the User Equipment is in communication (page 4, lines 6-27).

Regarding claim 18, Whinnett discloses a user equipment for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising means for updating a stored list of available other networks based on information supplied by the active network (page 4, line 26).

4. Claims 11,12, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Korpela et al. (US-6,510,146).

Regarding claim 11, Korpela et al. discloses a method of operating an active network with which User Equipment is in communication comprising a step of sending

neighbor cell information to User Equipment based on network preferences communicated by the User Equipment (col. 3, line 11-col.4, line 19).

Regarding claim 12, Korpela et al. discloses a method according to claim 11, as recited in the rejection of claim 11, comprising a step of sending mutually different neighbor cell information to mutually different User Equipments based on mutual different network preferences (col. 7, lines 34-42 and col. 3, lines 51-67).

Regarding claim 25, Korpela et al. discloses a mobile communications network or component thereof including means for- receiving from User Equipment communicating with the network an indication of a preferred other network and means for supplying neighboring cell information for the preferred other network (fig. 2 and col. 4, lines 53-65).

Regarding claim 26, Korpela et al. discloses a mobile communications network or component thereof including means for sending neighbor cell information to User Equipment based on network preferences communicated by the User Equipment (col. 3, line 11-col.4, line 19).

Regarding claim 27, Korpela et al. discloses a mobile communications network or component thereof according to claim 26, as recited in the rejection of claim 26, arranged to send mutually different neighbor cell information to mutually different User

Equipments based on mutually different network preferences (col. 3, line 11-col.4, line 19).

5. Claims 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodin (US-6,387,027).

Regarding claim 16, Bodin discloses in figure 1, a user equipment (2) for a mobile communications system capable of handover from an active network with which User Equipment is in communication to another network comprising means for storing a list of available 5 other networks supplied by the active network (fig.1, box 4 and col. 3, lines 26-29).

Regarding claim 17, Bodin discloses a user equipment according to claim 16, as recited in the rejection of claim 16, further comprising means for updating the stored list of available other networks based on information supplied by the active network (col. 3, lines 29-34).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whinnet in view of Rinne et al. (US-6,574,473).

Regarding claim 5, Whinnett discloses all the limitations of a method according to claim 4, as recited in the rejection of claim 4. Whinnet does not show the step of incrementally adding to or subtracting from the list of available networks. However, Rinne et al. teaches the step of incrementally adding to or subtracting from the list of available networks (col. 8, lines 5-8). Since both Whinnett and Rinne et al. are related to a method of operating user equipment capable of handover; then, it would have been obvious to one of ordinary skilled in the art at the time of the invention for including the step of incrementally adding to or subtracting from the list of available networks as taught by Rinne et al. into the method of Whinnet in order to provide the user equipment the function of selecting networks which offer better signal connection and eliminating networks which offer weak signal connection.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodin in view of Gourgue et al. (US-6,584,116).

Regarding claim 21, Bodin discloses all the limitations of a User Equipment according to claim 16, as recited in the rejection of claim 16. Bodin does not show wherein the active network is a UMTS network and the other network is a GSM network,

having means for communicating over both networks. However, Gourgue et al. teaches in figure 3, the active network is a UMTS network (50A) and the other network is a GSM network (51A), having means for communicating over both networks (col. 5, lines 5-7). Since both Bodin and Gourgue et al. are related to a user equipment for a mobile communications system capable of handover; then, it would have been obvious to one of ordinary skilled in the art at the time of the invention for including the active network is a UMTS network and the other network is a GSM network, having means for communicating over both networks as taught by Gourgue et al. into the user equipment of Bodin in order to provide uninterrupted service over different communication networks.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Einola et al. (US-6,438,370) discloses location update method and inter core network entity handover method.
 - b. Erlick et al. (US-6,614,769) discloses communication unit for seamless handover between networks and method of use therefor.
 - c. Van Den Heuvel et al. (US-6,223,030) discloses communications operating system and method therefor.
 - d. Lintulampi (US-6,377,804) discloses mobile communication system.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 703-305-9007. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Urban F Edward can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Jan. 07, 2004
Huy Phan

PABLO N. TRAN
PRIMARY EXAMINER



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01/08/04